UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,641	08/19/2003	Kent A. Hellebust	6541-66109	5484

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EXAMINER
NGUYEN, NAM V

ART UNIT	PAPER NUMBER
2635	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 July 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>24-39 and 41-44</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>24-39 and 41-44</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

This communication is in response to applicant's Amendment filed July 27, 2005.

An amendment to the claims 28 and 37-41 has been entered and made of record in the application of Hellebust et al. for a "filtered in-box for voice mail, e-mail, pages, web-based information, and faxes" filed August 19, 2003.

Claim 40 is cancelled.

Claims 24-39 and 41-44 are pending.

Response to Arguments

In view of applicant's amendment to amend the claim 28 to obviate the §112 rejections, therefore, examiner has withdrawn the rejection under 35 U.S.C §112, second paragraph.

Applicant's argument and amendments to the rejected claims are insufficient to distinguish the claimed invention from the cited prior arts or overcome the rejection of said claims under 35 U.S.C § 102(e) and 35 U.S.C § 103(a) as discussed below. Applicant's amendment and argument with respect to the pending claims 24-39 and 41-44, filed July 27, 2005, have been fully considered but they are not persuasive for at least the following reasons.

On page 5, last paragraph, Applicant's arguments with respect to the invention in Janow does not teach or suggest that the a receiver configured to receive a plurality of messages of a first format and a plurality of messages of a second format is not persuasive.

As defined by claim 24, a telecommunication network system of Janow includes a pager to receive plurality of messages which are voice, e-mail, video and Internet messaging platforms (Column 2 lines 8 to 40; see Figure 1). Janow suggests that the pager receives carrier signal from a paging system. The incoming carrier signal is from one of the messaging platforms. The display is activated by processor to show subscriber that a particular messaging platform instigated transmission of the received carrier signal to inform the subscriber that a message is waiting in a particular platform. The pager displays plurality of message's type, message's originator and many other ways (column 3 lines 4 to 21; see Figures 3). Clearly, the pager receives a plurality of messages of a first format and a plurality of messages of a second format and a display configured to present classification information associated with the messages of the first format and the second format.

Furthermore, Janow discloses that the pager 22 includes an interface to receive signal from a network 50 that is associated with a telephone's connection to the network 50. An interface circuitry 220 accepts DTMF signals at connectors 221 and 222 and converts them to digital signals that are applied to processor 211 (column 3 line 65 to column 4 line 24; see Figure 4). Also, the pager can also be connected to communication network 50 through a computer connected to the telecommunication network, rather than via a direct connection to a conventional telephone line (column 4 lines 25 to 65, see Figure 4). Clearly, the pager receives plurality of messages of plurality of formats.

On page 6, second paragraph, Applicant's arguments with respect to the invention in

Janow does not teach or suggest that the a receiver configured to receive messages of at least two

types for a wireless network user, and a processor configured to evaluate the received messages

based on a predetermined rule set and produce associated message classifications is not

persuasive.

The pager of Janow receives a plurality of messages of a first format and a plurality of

messages of a second format and a display configured to present classification information

associated with the messages of the first format and the second format. Processor 211 analyzes

the received page information to determine the urgency level of the message. The results of this

message can also be communicated via panel 215 and/or via the lit LED (column 3 lines 22 to

28). Clearly, the processor determines the rule set from the received page information.

Furthermore, the processor determines whether the intended recipient (e.g., subscriber

23) subscribes to the paging alert service. If so, the message is analyzed in block 101 to

determine whether paging alert criteria have been met. The criteria may relate to the identity of

the sender, to an urgency code in the message, time of day, etc. If block 102 determines that the

paging alert criteria have been met, block 103 constructs a page message and causes the platform

to forward the message to paging system 20. The message includes at least an indication

identifying the platform and, perhaps, additional information. Lastly, block 104 causes pager

system 20 to send a page to pager 21 (column 2 lines 41 to 54; see Figure 2). Clearly, the

processor determines the criteria (or rules) from the received page information messages.

On page 6, third paragraph, Applicant's arguments with respect to the invention in Janow does not teach or suggest that an input configured to receive rules associated with at least two message formats transmitted by a wireless network infrastructure is not persuasive.

The pager of Janow receives a plurality of messages of a first format and a plurality of messages of a second format and a display configured to present classification information associated with the messages of the first format and the second format. Processor 211 analyzes the received page information to determine the urgency level of the message according to a pre-selected algorithm. The results of this message can also be communicated via panel 215 and/or via the lit LED (column 3 lines 22 to 28). The pager of Janow includes an input interface 214, or at least portions of 214, can be correlated with display 213. Specifically, each of the LEDs can be built into a separate push button. Pushing a button associated with one of the messaging platforms can be used to retrieve and display (on panel 215) additional information about the associated message (including, for example, the 800 number that may be used by the subscriber to contact the particular messaging platform), and when pager 21 is a two-way pager, pushing the buttons can signal pager system 20 that the message was received and "read". More advanced communication from pager 21 to system 20 may even direct pager system 20 to contact the appropriate platform and forward the stored message to a specified destination (e.g., telephone 30, or some other telephone specified by the subscriber). Of course, pushing the button would also extinguish the LED associated with the button (column 3 lines 37 to 52). Clearly, the processor determines from a pre-selected algorithm to activating the alert device or displaying the message, and/or storing the message for later reference with an input interface.

Furthermore, the processor determines whether the intended recipient (e.g., subscriber 23) subscribes to the paging alert service. If so, the message is analyzed in block 101 to determine whether paging alert criteria have been met. The criteria may relate to the identity of the sender, to an urgency code in the message, time of day, etc. If block 102 determines that the paging alert criteria have been met, block 103 constructs a page message and causes the platform to forward the message to paging system 20. The message includes at least an indication identifying the platform and, perhaps, additional information. Lastly, block 104 causes pager system 20 to send a page to pager 21 (column 2 lines 41 to 54; see Figure 2). Clearly, the processor determines the criteria (or rules) from the received page information messages.

The examiner maintains that the references cited and applied in the last office actions for the rejection of the claims are maintained in this office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

Claims 24-27, 29-31, 33-39 and 42-44 are rejected under 35 U.S.C. 102(e) as being

anticipated by Janow (US# 6,061,570).

Referring to claim 24, Janow discloses a unified message announcing as recited in claim

1. See Figures 1 to 4 and respective portions of the apparatus and method.

Janow discloses a wireless communication device (21) (i.e. a pager) (column 1 lines 43 to

63; see Figures 1 and 3), comprising:

a receiver (210) (i.e. a RF section) configured to receive a plurality of messages of a first

format (10) (i.e. voice messaging) and a plurality of messages of a second format (20) (i.e. a

paging system) (column 2 lines 30 to 40; see Figures 1 to 3); and

a display (213) configured to present classification information (i.e. the message's

originator or the message's type) associated with the messages of the first format (10) (i.e. voice

messaging) and the second format (20) (i.e. a paging system) (column 2 lines 30 to 40; column 3

lines 4 to 21; see Figures 1 to 3).

Referring to claim 25, Janow discloses a wireless communication device of claim 24,

further comprising a processor (211) (i.e. a digital processor) configured to determine the

classification information for the plurality of messages of the first format and the plurality of

messages of the second format (column 3 lines 22 to 29; see Figure 3).

Referring to claim 26, Janow discloses a wireless communication device of claim 25, further comprising a memory (212) (i.e. a storage memory), wherein the processor (211) is configured to determine the classification information based on at least one a rule (i.e. criteria) stored in the memory (212) (column 2 lines 41 to 66; column 3 lines 4 to 21; see Figures 2 to 3).

Referring to claim 27, Janow discloses a wireless communication device of claim 25, wherein the processor (211) is configured to produce updated classification information, and the display is configured to present the updated classification information (column 2 lines 41 to 66; column 3 lines 4 to 21; see Figures 2 to 3).

Referring to claim 29, Janow discloses a wireless communication device of claim 25, wherein the classification information includes information about an origin (i.e. the message's originator) of at least one received message (column 3 lines 14 to 21; see Figures 1 and 3).

Referring to claim 30, Janow discloses a wireless communication device of claim 24, wherein the receiver (21) is configured to receive a plurality of messages of a third format (11) (i.e. e-mail messages) (column 2 lines 8-40; see Figure 1).

Referring to claim 31, Janow discloses a wireless communication device of claim 24, where the first format is a voice mail format (10) (i.e. voice messaging) (column 2 lines 8-40; see Figure 1).

Referring to claim 33, Janow discloses a wireless communication device of claim 24, where the first format is an e-mail format (11) (i.e. e-mail messaging) (column 2 lines 8-40; see Figure 1).

Referring to claim 34, Janow discloses a wireless communication device of claim 24, where the first format is a paging format (20) (i.e. paging system) (column 2 lines 8-40; see Figure 1).

Referring to claim 35, Janow discloses a wireless communication device of claim 24, where the first format is a short message service format (30) (i.e. telephone service) (column 2 lines 8-40; see Figure 1).

Referring to claim 36, Janow discloses a wireless communication device of claim 24, where the first format is based on a Wireless Markup Language (13) (i.e. internet messaging) (column 2 lines 8-40; see Figure 1).

Referring to claims 37 and 44, Janow discloses a network device for a wireless infrastructure, the claims 37 and 44 differ from claim 24 in that the claims require the limitations of claims 25-26 already addressed above and Janow discloses all limitations to the extent as claimed with respect to claim 24 above and therefore claims 37 and 44 are also rejected for the same reasons given with respect to claims 25-26.

Referring to claim 38, Janow discloses a network device of claim 37, further comprising a transmitter (20) (i.e. transmitter of a paging system) configured to transmit the message classification (column 2 lines 9 to 19; column 3 lines 4 to 21; see Figures 1 and 3).

Referring to claim 39, Janow discloses a network device of claim 37, wherein the transmitter (20) (i.e. transmitter of a paging system) is configured to transmit the received message to the wireless network user (23) (i.e. a subscriber) (column 2 lines 9 to 19; see Figure 1).

Referring to claims 42-43, Janow discloses a network device of claim 37, the claims 42-43 same in that the claims 26-27 already addressed above therefore claims 42-43 are also rejected for the same reasons given with respect to claims 26-27.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 32 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janow

(US# 6,061,570) as applied to claims 24 and 37 above, and in view of Keyworth II et al. (US#

5,579,472).

Referring to claim 32, Janow discloses a wireless communication device of claim 24,

however, Janow did not explicitly disclose wherein the first format is a fax format.

In the same field of endeavor of a wireless communication device, Keyworth II et al.

teach that the first format (38) (i.e. fax mail) is a fax format (column 3 lines 46 to 54; column 5

line 46 to 54; see Figures 1 to 4) in order to receive and to display fax messages on the display

from an external source.

One of ordinary skilled in the art recognizes the need to add a fax format in an exemplary

apparatus of Keyworth II et al. in a multi-service notifier device of Janow because Janow

suggests it is desired to provide that a multi-service notifier device able to receive plurality of

message formats including telephone, internet messaging and e-mail messaging on a

conventional telephone line (column 2 line 9 to 20; see Figure 1) and Keyworth II et al. teach

that an apparatus able to receive a fax on a modem or a wireless receiver from a telephone jack

(column 5 lines 47 to 54) in order to have a successful communication and display for reviewing

new messages. Therefore, it would have been obvious to a person of ordinary skill in the art at

the time of the invention was made to add a fax format in an exemplary apparatus of Keyworth,

II et al. in a multi-service notifier device of Janow with the motivation for doing so would have

been to provide an additional service of a multi-service notifier device.

Referring to claim 41, Janow discloses a network device of claim 37, Keyworth, II et al.

disclose wherein the processor is configured to produce an updated message count (50e) (i.e.

updated status of number incoming messages) associated with the message classification (i.e.

type) (column 4 lines 31 to 41; see Figures 1-3).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37
CFR 3.73(b).

Claim 28 is rejected under the judicially created doctrine of double patenting over claim 1

of U. S. Patent No. 6,628,194 since the claims, if allowed, would improperly extend the "right to

exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is

covered by the patent since the patent and the application are claiming common subject matter,

as follows:

Claim 1 of Hellebust et al. disclose wherein the receiver (i.e. receiver of a wireless device 101) is configured to receive classification information associated with messages from the plurality of messages of the first format and the plurality of messages of the second format, and the display is configured to display number of messages (i.e. counter) of the first format or a number of messages of the second format (see Figures 1-3).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nam V Nguyen whose telephone number is 571-272-3061. The

examiner can normally be reached on Mon-Fri, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Michael Horabik can be reached on 571-272-3068. The fax phone numbers for the

organization where this application or proceeding is assigned are 571-273-8300 for regular

communications.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nam Nguyen
October 13, 2005

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